UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,517	01/28/2000	Matthew Fuchs	16603-708	2359

22470	7590	05/14/2004

HAYNES BEFFEL & WOLFELD LLP
P O BOX 366
HALF MOON BAY, CA 94019

EXAMINER
NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
2176	13

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-35* is/are pending in the application.

    4a) Of the above claim(s) *1-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *8-9*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: Response to Restriction Requirement filed

02/13/2004 to the original application filed 01/2000; IDS filed 08/07/2002 and 11/12/2002.

2.   Claims 14-35 are elected for examination. Claims 14, 25, and 31 are independent claims.

Specification

3.   The abstract of the disclosure is objected to because it exceeds the limit of 150 words.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

The limitation *"wherein a definition of the second tag includes the plurality of elements*

from the markup language an additional element from the markup language" (claim 14, lines 11-

14) is unclear. The examiner does not understand the meaning of *"wherein a definition of the*

second tag includes the plurality of elements from the markup language an additional element

from the markup language."

Dependent claims 15-24 are also rejected for fully incorporating the dependencies of their

parent claim.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed
publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 25 is rejected under 35 U.S.C. 102(a) as being anticipated by **W3C**, "XML

Schema part 1: Structure", 06/05/1999, as cited by Applicant's IDS (paper #9).

As to independent claim 25, W3C teaches a computer network system for processing a

document instance of a markup language *(XML documents; Section 2.1)*, the computer system

comprising:

- defining a first schema in the computer network system *(An XML document that defines*

a schema;2.1);

- extending a definition the first schema by use of a second schema residing on the

computer network system; and importing the second schema into the document instance *(Schema*

Import: Extends the current schema with definitions and/or declarations from an external

schema; 2.4 and also Sections 4.4).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14-17, 19-22, 26-31 and 35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over **W3C.**

As to independent claim 14, W3C teaches a method of extending a definition of a first

tag used in a first electronic document *(e.g., extends the current schema; Sections 2.4 and 4.4),*

wherein the electronic document is encoded in a markup language *(e.g., XML document; Section*

2.1), and the document is stored on a server in a computer network, the method comprising:

     - defining the first tag in a first schema, wherein the definition of the first tag includes a

plurality of elements from the markup language *(e.g., see Schema Definitions and Declarations;*

Section 3);

     - defining a second tag in a second schema, wherein a definition of the second tag

includes the plurality of elements from the markup language an additional element from the

markup language *(e.g., see Schema Definitions and Declarations; Section 3).*

- accessing the first schema and second schema in the first electronic document *(e.g.,*

XML schemas are themselves specified as XML documents ...schema definition documents are

accessed during processing; Section 2.1).

While teaching defining tags in schemas, W3C does not explicitly teach using tags to

encode text.

However, W3C discloses "an XML 1.0 DTD may declare an element type as containing

character data, elements, or mixed content" *(Section 2.2).*

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have applied W3C's teaching to include "using tags to encode text" in order to

provide means for demarcating data content and data fields so that the content can be interpreted

and manipulated.

As to dependent claim 15, W3C teaches parsing the first electronic document *(e.g.,*

External Parsed Entity Declaration; Section 3.6.2).

W3C does not teach "the parser being stored on the server". However, W3C discloses

"Schema-aware processors and provide for an external processing system to have access to the

combined information set document instance plus schema information." *(Section 6.2.)*

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have applied W3C's teaching to include the parser being stored on the server in

order to provide means for accessing and manipulating XML schemas in a computer network

system.

As to dependent claim 16, W3C teaches the second tag is used in a location reserved for

the first tag in the electronic document *(Section 2.4).*

As to dependent claim 17, W3C teaches the markup language is XML (XML documents; 2.1)

As to dependent claim 19, W3C teaches the first electronic document includes the first tag and the second tag *(e.g., Schema Definition; Sections 2.1 and 2.2)*.

As to dependent claims 20-21, note the discussion of claims 14-15 above for the rejection.

As to dependent claim 22, it includes the same limitations as in claim 17, and is similarly rejected under the same rationale.

As to dependent claim 26, it includes the same limitations as in claim 17, and is similarly rejected under the same rationale.

As to dependent claim 27, W3C teaches the definition of the first schema includes a definition of a tag *(e.g., Schema Definition; Sections 2.1 and 2.2)*.

As to dependent claim 28, W3C teaches extending the definition of the tag by use of the second schema *(Section 2.4)*.

As to dependent claim 29, W3C teaches the document instance includes the tag *(e.g., Datatype Definition, Section 3.4.1)*.

As to dependent claim 30, W3C teaches using an extension of the tag in the document instance, wherein the extension of the tag is used in a location reserved for the tag in the document instance *(Section 2.4 and 6.2)*.

As to independent claim 31, W3C teaches a method of interpreting an XML document *(XML documents; Section 2.1)*, the method comprising:

- accessing a first schema *(e.g., XML schemas are themselves specified as XML*

documents ...schema definition documents are accessed during processing; Section 2.1),

wherein the first schema defines one or more elements used in the document instance *(e.g.,*

Schema Definition; Sections 2.1 and 2.2);

- accessing a second schema *(e.g., XML schemas are themselves specified as XML*

documents ...schema definition documents are accessed during processing; Section

2.1),wherein the second schema modifies at least one element from the one or more elements

used in the document instance *(e.g., extends the current schema with definitions and/or*

declarations from an external schema; Section 2.4 and 6.2).

W3C does not explicitly teach "a first server, a second server, and a third server".

However, W3C discloses "Schema-aware processors and provide for an external

processing system to have access to the combined information set document instance plus

schema information." (Section 6.2.)

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have applied W3C's teaching to include a first server, a second server, and a third

server in order to provide means for accessing and manipulating XML schemas in a computer

network system.

As to dependent claim 35, W3C teaches parsing the XML document *(e.g., External*

Parsed Entity Declaration; Section 3.6.2).

W3C does not teach "a fourth server". However, W3C discloses "Schema-aware

processors and provide for an external processing system to have access to the combined

information set document instance plus schema information." *(Section 6.2.)*

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have applied W3C's teaching to include a fourth server in order to provide means

for accessing and manipulating XML schemas in a computer network system.

7.   Claims 18, 23-24, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable

over **W3C** in view of **Usdin et al.** "XML: Not a Silver Bullet, But a Great Pipe Wrench",

09/1998.

As to dependent claim 18, W3C does not explicitly teach "the first document

corresponds to at least one of a purchase order, a purchase order acknowledgement, an order

status check, an availability check, a price check, an invoice, an invoice acknowledgement."

Usdin teaches the first document corresponds to at least one of a purchase order, a

purchase order acknowledgement, an order status check, an availability check, a price check, an

invoice, an invoice acknowledgement (XML/EDI ... *provides a standard framework/format to*

describe different types of data ... an invoices ...the information, whether in a transaction,

catalog ...by implementing EDI; page 130, second right paragraph).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to include the feature from Usdin in the system of 3WC because it would have

provided the capability for using XML to encode information and services with meaningful

structure and defining XML business documents that agents, as well as people, can understand

easily.

As to dependent claim 23, W3C does not explicitly teach "the second document

corresponds to a commercial transaction."

Usdin teaches the second document corresponds to a commercial transaction *(page 130, second right paragraph)*.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Usdin in the system of 3WC because it would have provided the capability for using XML to encode information and services with meaningful structure and defining XML business documents that agents, as well as people, can understand easily.

As to dependent claim 24, it includes the same limitations as in claim 18, and is similarly rejected under the same rationale.

As to dependent claim 32, W3C does not explicitly teach "the computer network system is used to conduct a commercial transaction between two or more trading partners."

Usdin teaches the computer network system is used to conduct a commercial transaction between two or more trading partners *(XML and E-Commerce; page 130)*.

As to dependent claim 33, notes the discussion of claim 23 above for the rejection.

As to dependent claim 34, it includes the same limitations as in claim 18, and is similarly rejected under the same rationale.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

| Blinn et al. | U.S Patent No. 5,974,418 | issue dated: Oct. 26, 1999 |
| Hickman et al. | U.S Patent No. 6,393,466 | issue dated: May 21, 2002 |

Call   U.S Patent No. 6,418,441   issue dated: Jul. 9, 2002

Bowker et al.   U.S Patent No. 6,601,071   issue dated: Jul. 29, 2003

Glushko et al. "An XML Framework for Agent-based E-commerce", Communications of

the ACM, Vol.42, No.3, March 1999, pages 106-113.

Meltzer et al. "XML and Electronic Commerce: Enabling the Network Economy',

Sigmod Record, Vol.27, No.4, December 1998, pages 21-28.

James Tauber, "XML After 1.0: You Ain't Seen Nothin' Yet", IEEE Internet Computing,

June 1999, pages 100-102.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092.

The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph H Feild can be reached on (703) 305-9792.

The fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
May 1, 2004
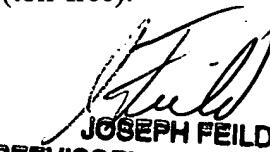
JOSEPH FEILD
SUPERVISORY PATENT EXAMINER